

REMARKS

Prior to entry of this Amendment, the application included claims 1-24. Claims 1-24 were rejected in the Office Action mailed February 20, 2009. Claims 1, 2, 8, 9, 12, 15, and 18 have been amended. No claims have been added or canceled. Hence, after entry of this Amendment, claims 1-24 stand pending for examination.

Claims 1-24 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Lineman et al. (U.S. Publication No. 2003/0065942) ("Lineman").

Rejections Under 35 U.S.C. § 101:

Claims 1-24 stand rejected as directed to non-statutory subject matter. Independent claims 1 and 12 have been amended to overcome the rejections; the rejections of claim 21 and its associated dependent claims are respectfully traversed. The Office Action states that: "An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a §101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps...." *Office Action*, pp. 2, 3, emphasis maintained.

Independent claims 1 and 12, as amended, recite a "host computer system including a processor...." These limitations tie their respective claims and dependent claims to a "particular machine or apparatus." Namely, each is tied to a form of a computing device.

As the claims presently stand, it is impossible to perform all of the method steps recited in the independent claims without the use of a particular apparatus. Thus, each of claims 1 and 12, and the claims that depend therefrom, satisfy the requirements of §101. The withdrawal of the §101 rejections is respectfully requested.

With regard to claim 21, claim 21 is not a method claim. Claim 21 recites:

A computer-readable storage medium having a computer-readable program embodied therein for direction operation of a security

compliance authority server including a communications system, a processor, and a storage device, wherein the computer-readable program includes instructions for operating the security compliance authority server to assess a security risk for an merchant entity having connectivity to a shared network in accordance with the following:...

Emphasis added. This is not a process claim, therefore the precedence cited by the Office Action is not relevant to the claim. Applicant respectfully requests withdrawal of the §101 rejections of claim 21 and its associated dependent claims.

Rejections Under 35 U.S.C. 102(e):

Claims 1-24 stand rejected as anticipated by Lineman. The Office Action states that claim 1, in its entirety, is taught by paragraphs 36-39 and 78-96 of Lineman. *Office Action*, pp. 3, 4. Applicant respectfully traverses this rejection. Claim 1 recites:

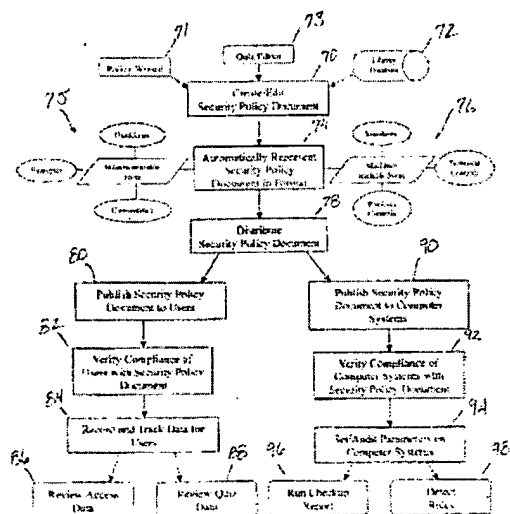
receiving at a host computer system including a processor, from each of a plurality of payment-processing organizations, a set of security requirements defining protocols for implementing commercial transactions over the shared network using instruments identified with the payment-processing organization; developing with the processor at the host computer system, a security test scheme having a set of test requirements whose satisfaction by the merchant entity is sufficient to ensure compliance with the sets of security requirements defined by each of the plurality of payment-processing organizations....

Emphasis added. Claims 12 and 21 contain similar recitations.

Lineman discloses a software program capable of creating and managing security policies on a network. *Lineman*, Abstract.

The disclosed software is directed to electronically creating a security policy document, which contains appropriate controls required to enforce the security policy on various computing platforms. The disclosed software creates a direct link between the security policy documents that are created and distributed to people and the controls sent to computers on the network.

Id., at ¶8. More specifically, Figure 2, reproduced here, illustrates the steps for creating, managing and enforcing security policies related to the disclosed software.



In describing Figure 2, Lineman states: “The disclosed software enables a security administrator to create and edit a security policy document (block 70).” *Lineman*, ¶32, emphasis added. This is different from the recitations of claims 1, 12, and 21. Claim 1 recites receiving “from each of a plurality of payment-processing organizations...,” then “developing... a security test scheme having a set of test requirements.... is sufficient to ensure compliance with the sets of security requirements defined by each of the plurality of payment-processing organizations.” Emphasis added.

For at least this reason, not every recitation of claims 1, 12, and 21 is taught by Lineman. Therefore, a *prima facie* case of anticipation has not been established. Accordingly, Applicant respectfully requests withdrawal of the §102 rejections of claims 1, 12, and 21.

Claim 5 recites that a satisfaction level of the test requirements required for compliance with the test requirements is dependent on “a shared-network transaction volume processed by the merchant entity over the shared network.” Claim 17 contains a similar recitation. *Office Action*, p. 6. The Office Action states that paragraph 90 of Lineman teaches this recitation. Applicant respectfully traverses the rejection.

Lineman does not disclose any requirements based on a transaction volume. Rather, the cited portion of Lineman discloses the use of a “metacommand language to allow the security management program and the agent software to communicate in a common language....” *Lineman*, ¶90. It is unclear how any statement in ¶90, or the remainder of the

specification, could be fairly read as teaching that a satisfaction level of the test requirements required for compliance with the test requirements is dependent on "a shared-network transaction volume processed by the merchant entity over the shared network." For at least this reason, Applicant respectfully requests withdrawal of the §102 rejection of claims 5 and 17.


Further, claims 2-11, 13-20, and 22-24 each depend, either directly or indirectly, from claims 1, 12, and 21, and are allowable at least by virtue of their dependence on an allowable base claim.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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